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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,195	04/17/2001	Andrew Dames	P07109US00/	6088
881	7590	04/26/2004	EXAMINER	
STITES & HARBISON PLLC 1199 NORTH FAIRFAX STREET SUITE 900 ALEXANDRIA, VA 22314			QUAN, ELIZABETH S	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/787,195	Applicant(s) DAMES ET AL.	
	Examiner Elizabeth Quan	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>04212004</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Previously, a written lack of unity was mailed to the Applicant, who responded by electing. However, upon further search and consideration, it was deemed necessary to provide another lack of unity requirement since claim 1 of Group I, which previously included claims 1-16 in which claims 1-10 is directed to the device and claims 11-16 is directed to the method of making the device, was found obvious over the prior art. The Office regrets the inconvenience this has caused the Applicant.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-10, drawn to a solid support.

Group II, claim(s) 11-16, drawn to a method of fabricating the supports.

Group III, claim(s) 17-21, drawn to an optical reader.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I and II do not require the specific technical features of Group III, such as an optical reader. The invention of Group III also operates in a manner totally different than that of Groups I and II and would be classified in a different area. Regarding Groups I and II, claim 1 is obvious over WO 96/41236 to Ferrari that teaches a solid support (20) with dimensions of not more than 3 microns (figs. 1-20; page 3, lines 7-10; page 6, lines 15-20). The support (20) is substantially linear or planar in shape and has a metal surface layer (figs. 1-20; page 7, line 10-page 15, line 21). Ferrari does not explicitly teach that the metal surface layer is anodized. <http://www.dictionary.com> defines anodize as to coat (a metallic surface) electrolytically with a protective or decorative oxide. <http://www.m-w.com> define anodize as to subject (a metal) to electrolytic action as the anode of a cell in order to coat with a

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protective or decorative film. EP 0 395 300 A2 to Burrell et al. characterizes anodization as an inexpensive process with precise thickness control for high reproducibility and uniformity (page 2, lines 48 and 49). Anodization causes a thick barrier film of metal oxide to grow at the metal surface and thickness of the film is such that reflections from the surface of the film and reflections from the underlying metal interfere and generate high visible colors, which is advantageous in diagnostic devices (page 2, lines 28-43). Reagent materials can be coated relatively easily on the anodic film (page 4, line 40). Since it is desirable to decorate and protect the solid support with a film that can be easily coated with reagents and generate highly visible colors conducive to diagnostic tests, it would have been obvious to one of ordinary skill in this art at the time this invention was made to anodize the metal layer of Ferrari. As the recited structure does not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate. Furthermore, the invention of Group I is totally different than that of Group II would be classified in a different area.

3. A telephone call was made to B. Aaron Schulman on 4/21/2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Quan whose telephone number is (571) 272-1261. The examiner can normally be reached on M-F (8:00-4:30).


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elizabeth Quan
Examiner
Art Unit 1743

eq


Jill Warden
Supervisory Patent Examiner
Technology Center 1700